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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,621	02/15/2001	Diether Rueppel	1998 / F-085	1893

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EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,621

Applicant(s)

Rueppel et al.

Examiner

Susan Tran

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1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 12, 2002

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 16-35 is/are pending in the application.

4a) Of the above, claim(s) 34 and 35 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 16-33 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of applicant's Declaration filed 02/15/01 and 04/12/02, Preliminary Amendment A filed 02/15/01, Information Disclosure Statement filed 02/15/01, and Election filed 04/12/02.

Election/Restrictions

1. Applicant's election with traverse of group I, claims 16-33 invention in Paper No.9, 04/12/02 is acknowledged.

Applicant argues that there is no undue burden on the Examiner to search all the groups together.

Requirement for restriction practice are set forth in MPEP§803.

A serious burden on the examiner is shown according to the criteria of MPEP§808.02, where one of the following must be supported by appropriate explanation:

1. Separate classification thereof;

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

2. A separate status in the art when they are classifiable together; and
3. A different field of search.

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In the restriction requirement dated 03/09/01, the examiner set forth separate classification for the three inventions to which claims were presented. Classification of the composition claims is 424, and classification of the process claims is 264. Applicant has not alleged that either the composition or the process claims were improperly classified. Nor has applicant alleged that the classifications set forth are not separate classifications. Thus, requirements 1 and 2 of MPEP§803 are met. For those reasons set forth above, the restriction requirement is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16, 32, and 33 are indefinite in the use of the phrases "particular time", and "some random variation depending on the circumstances". The metes and bounds of the patent protection are unascertainable.

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Regarding claim 20, the phrase "other auxiliary" renders the claim indefinite because the claim include elements not actually disclosed (those encompassed by "other"), thereby rendering the scope of the claim unascertainable.

Claim 26 is rejected for failure to further limit the subject matter of claim 18. It is suggested to amend the dependency to "claim 19".

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-22, 27, 28, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo et al. US 6,358,520, in view of Hasslin US 5,674,514.

Lo teaches pesticides composition comprising microencapsulated pesticides in polymeric shell in the form of a matrix for controlled release (columns 2-5). The polymeric shell containing water soluble polymer, such as polyethylene, polyvinylpyrrolidone, and copolymers (column 3, lines 46-62). The composition further comprising surfactant, and the microparticle having diameter of about 3 μm (ID). Lo does not teach the claimed copolymer, such as cycloolefin.

Hasslin teaches formulation comprising particles containing pesticide mixture, polymer, and copolymer (columns 1-3). The polymer or copolymer can be mixtures of olefin, polyolefin,

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and cycloolefin, such as, cyclopentene or norbornene (column 3, lines 33-65). The formulation further comprising surfactant, emulsifying agents, or dispersant (columns 6-8). The particles obtained having diameter from 0.5 μm to 12 μm (column 9, lines 11-48). Thus, it would have been prima facie obvious for one of ordinary skill in the art to modify Lo's copolymer using the cycloolefin in view of the teaching of Hasslin, because the references teach the advantageous result in the use of pesticides composition in microparticles form. The expected result would be microcapsule in a matrix for controlled release of pesticides.

4. Claims 23-26, 29, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masters US 6,342,250, and Epple et al. US 5,376,725.

Masters teaches microparticle drug delivery system for controlled release comprising polymeric materials, one or more active agents, and excipients in matrix form (columns 5-6). The polymers and copolymer are disclosed in columns 9-10. Masters does not teach the claimed copolymer, such as cycloolefin.

Epple teaches cycloolefin polymers can be used in matrix materials having viscosity of greater than 20 cm^3/g , and glass transition temperature of between 100 ° and 200°C (columns 3-4). Thus, it would have been obvious for one of ordinary skill in the art to prepare Masters' drug delivery system using the polymer of Epple, because Epple teaches the advantageous result in the use of polyolefin copolymer in matrix materials. The expected result would be a controlled release device having improve release rate useful in pharmaceutical art.

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Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brauer et al., Muller et al., Ohtani et al., and Brown et al. are cited as being of interest for the teaching of microparticles comprising polymers and copolymers.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600